



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,470	06/27/2001	Masanori Nakahara	041465-5112	1384

55694 7590 12/18/2006

DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005-1209

EXAMINER

FLETCHER, JAMES A

ART UNIT	PAPER NUMBER
----------	--------------

2621

DATE MAILED: 12/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/891,470	Applicant(s) NAKAHARA ET AL.	
	Examiner James A. Fletcher	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,27-32 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24,27-32 and 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed December 1, 2006 have been fully considered but they are not persuasive.

In re page 22, Applicant's Representative states: "Kawara does not disclose, or even suggest, permission information indicating whether or not to permit at least one of the front and rear part record information to be further divided, in the manner specifically described in independent claim 1 of the instant application."

The Examiner respectfully disagrees. By restricting reproduction of any part of an information, Kawara explicitly also restricts any manipulation of the reproduction-restricted part. The Examiner suggests that a limitation that reads to the effect of dividing a reproducible part would overcome the rejection based on the cited prior art.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 6, 11, 14, 16-17, 19, 22, 27-32, and 34-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawara et al (6,278,836).

Regarding claims 1, 11, and 19, Kawara et al disclose an information recording apparatus and method comprising:

- a device, process, and program for specifying a division timing in the recording information (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions");
- a device, process, and program for recording in the recording medium front part record information that is the record information before the specified division timing and rear part record information that is the record information after the specified division timing, the division timing being a timing to divide continuous record information into two or more items of part information (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions");
- a device, process, and program for generating permission information indicating whether or not to permit at least one of the front and rear part record information to be further divided (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the

first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions"); and

- a device, process, and program for recording the generated permission information in the recording medium (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions").

Regarding claims 27 and 29, Kawara et al disclose an information recording apparatus, process, and program wherein the part record information before and after the division timing correspond to a different part of the divided record information from each other (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions").

Regarding claims 4, 14, and 22, Kawara et al disclose an information recording apparatus, method, and program comprising:

- a device, process, and program for detecting permission information from a recording medium having record information and permission information (Col

7, lines 24-30 "reproduction restricting information for performing reproduction restriction of a part or the whole of the main information. Therefore, reproduction of information, which is recorded on an information recording medium such as an optical disk and available by reproduction, can be restricted in a desired mode, whereby the use of a software, such as a movie or a computer program, can be restricted") indicating whether or not to permit execution of edit processing for dividing the record information into two or more items of part record information recorded therein (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions");

- a device, process, and program for judging the content of the detected permission information (Col 7, lines 24-30 "reproduction restricting information for performing reproduction restriction of a part or the whole of the main information. Therefore, reproduction of information, which is recorded on an information recording medium such as an optical disk and available by reproduction, can be restricted in a desired mode, whereby the use of a software, such as a movie or a computer program, can be restricted"); and
- a device, process, and program for only when the judged content corresponds to the content in which the division processing is enabled,

executing the edit processing (Col 7, lines 24-30 "reproduction restricting information for performing reproduction restriction of a part or the whole of the main information. Therefore, reproduction of information, which is recorded on an information recording medium such as an optical disk and available by reproduction, can be restricted in a desired mode, whereby the use of a software, such as a movie or a computer program, can be restricted").

Regarding claims 6 and 16, Kawara et al disclose an information recording apparatus, method, and program comprising:

- a device, process, and program for specifying a division timing to divide the record information, the division timing being a timing to divide continuous record information into two or more items of part information (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions");
- a device, process, and program for dividing the record information into front and rear part record information (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of

reproduction according to the fourth embodiment is performed for the rest of the portions"); and

- a device, process, and program for generating permission information having the same content as the permission information recorded in the medium before division, relevant to each of the front and rear record information, then recording the information in the recording medium (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions").

Regarding claims 28 and 30, please refer to Examiner's remarks regarding claims 27 and 29 above.

Regarding claim 17, Kawara et al disclose an information recording medium comprising:

- a record information area having one or plural items of recording information recorded therein (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions"); and

- a permission information recording region having permission information indicating whether or not to permit execution of edit processing for dividing each item of recording information into one or more items of part record information (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions").

Regarding claim 31, please refer to Examiner's remarks regarding claims 27 and 29 above.

Regarding claim 24, Kawara et al disclose an information-recording medium having recorded therein a recording control program causing a recording computer to function as:

- a device for specifying a division timing to divide the record information, the division timing being a timing to divide a continuous record information into two or more items of part information (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions");

- a device for dividing the record information into front and rear part record information after the specified division timing (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions"); and
- a device for generating permission information having the same content as the permission information recorded in the recording medium before being divided, relevant to each of the front and rear part record information, and recording the information in the recording medium (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions").

Regarding claim 32, please see Examiner's remarks regarding claims 27 and 29 above.

Regarding claims 34, 36, and 38, Kawara et al disclose a specification device, method, and program for specifying a division timing to divide the record information, the division timing being a timing to divide continuous record information into two or more items of part information;

- a management information generating device, method, and program for generating management information for managing front part record information and rear part record information based on management information for managing the record information before the division by the division timing, the front part record information being the record information before the specified division timing, the rear part record information being the record information after the specified division timing (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions");
- wherein the management information includes permission information for managing front part and rear part record information based on management information for managing the record information before the division by the division timing, the front part record information being the record information before the specified division timing, the rear part record information being the record information after the specified division timing (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions

while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions”),

- wherein the management information includes permission information indicating whether or not to permit at least one of the front part record information and the rear part record information to be further divided (Col 37, lines 61-67 “recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions”).

Regarding claims 35, 37, and 39, Kawara et al disclose an information recording apparatus, method, and program comprising:

- a permission information detection device and process for detecting the permission information from a recording medium having record information and permission information indicating whether or not to permit execution of edit processing for dividing the record information into two or more items of part record information recorded therein (Col 37, lines 61-67 “recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions”);

- a judgment device and process for judging the content of the detected permission information (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions"); and
- an execution device and process for, only when the judged content corresponds to the content in which the division processing is enabled, executing the edit processing (Col 37, lines 61-67 "recorded information corresponding to a single title is divided into plural portions, and reproduction restriction for a prescribed period of time according to any of the first to third embodiments is performed to some of the portions while trial permission of reproduction according to the fourth embodiment is performed for the rest of the portions")

Further regarding claims 35, 37, and 39, please refer to Examiner's remarks regarding claims 34, 36, and 38 above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawara et al.

Regarding claims 7 and 9, Kawara et al disclose an information recording apparatus wherein the record information comprises audio information (Col 4, lines 18-22 “an information reproducing apparatus for reading out main information being a target of reproduction and including at least one of video information and audio information and auxiliary information to control reproduction of the main information”), but does not specifically disclose that the audio information contains music and voice information.

The examiner takes official notice that music and voice are notoriously well-known and widely used types of audio information, being used in a multitude of recording genres, channels, and formats.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kawara et al to specify audio data as including music and voice information.

Regarding claims 8 and 10, Kawara et al disclose an information recording apparatus wherein the recording medium comprises an optical disc capable of information recording (Col 1, lines 13-14 “The invention also relates to information recording media such as optical disks for recording compressively encoded video signals and program information”), but does not specifically disclose that the disc is a recordable DVD.

The Examiner takes official notice that recordable DVDs are notoriously well known, commercially available, and widely used devices, allowing users to store large amounts of audio and video information in an inexpensive medium with wide compatibility.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kawara et al by including a recordable DVD as the medium.

6. Claims 3, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawara et al as applied to claims above, and further in view of Itoh et al (6,700,989).

Regarding claims 3, 13, and 21, Kawara et al disclose an information recording apparatus, method, and program comprising:

- a device, process, and program for detecting the permission information recorded in the recording medium (Col 7, lines 24-30 “reproduction restricting information for performing reproduction restriction of a part or the whole of the main information. Therefore, reproduction of information, which is recorded on an information recording medium such as an optical disk and available by reproduction, can be restricted in a desired mode, whereby the use of a software, such as a movie or a computer program, can be restricted”);
- Kawara et al are silent on the subject of changing the detected permission information and overwriting the changed permission information on the recording medium. Itoh et al teach a device, process, and program for

detecting the permission information (Col 31, lines 46-49 "the copy control information contained in the read-out/received data controls if the moving image is to be actually outputted [to be recorded or/and displayed], so as to permit or bar the image output"), changing the content of the detected permission information (Col 28, lines 4-7 "in the one-copy mode, a child [a copy] can be formed, but the formed copy is set in the no-more-copy mode, so that a copy corresponding to a grandchild cannot be formed"); and overwriting the changed permission information on the recording medium (Col 9, lines 28-32 "The moving image in which the watermark information and the copy restriction information have been inserted in accordance with the present invention, is stored in any of various storage media").

As taught by Itoh et al, detecting copy permission data, changing that copy permission data, and recording that changed copy permission data on the recording medium is well known, widely used, and commercially available means of allowing a finite number of copies of program data to be made, thereby enabling a particular level of enforcement of copy protection.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kawara et al in order to modify copy permission data from the medium and record that changed copy permission data on the medium.

Art Unit: 2621

7. Claims 2, 5, 12, 15, 18, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawara et al as applied to claims above, and further in view of Kikuchi et al (6,577,811).

Regarding claims 2, 5, 12, 15, 18, 20, and 23, Kawara et al are silent on the topic of erasing data from a medium after performing editing of that data.

Kikuchi et al teach an information recording apparatus and method wherein the permission information takes any one of:

- a first state in which it is enabled that at least either one of the front and the rear record information is erased from the recording medium after [being] recorded (Col 69, lines 50-56 "D-PRO 36X...erases data [files or VTS] recorded on disc 10X under the control of microcomputer block [MPU] 30X"), and that the information is further divided (Col 71, line 66 - Col 72, line 3 "MPU 30X...has an erase prohibition range specification function, erase prohibition setting function, cell divide function, and erase prohibition detection function for cell units, thus improving the operability of the system for the user");
- a second state in which it is disabled that the information is erased from the recording medium after [being] recorded (Col 69, lines 7-9 "a program which has already been played back but is to be kept can be prevented from being inadvertently erased by, e.g., overwrite by setting the archive flag"), but it is enabled that the information is further divided (Col 71, line 66 - Col 72, line 3 "MPU 30X...has an erase prohibition range specification function, erase

prohibition setting function, cell divide function, and erase prohibition detection function for cell units, thus improving the operability of the system for the user"); and

- a third state in which it is disabled that the information is erased from the recording medium after [being] recorded (Col 69, lines 50-56 "D-PRO 36X...erases data [files or VTS] recorded on disc 10X under the control of microcomputer block [MPU] 30X"), and that the information is further divided (Col 71, line 66 - Col 72, line 3 "MPU 30X...has an erase prohibition range specification function, erase prohibition setting function, cell divide function, and erase prohibition detection function for cell units, thus improving the operability of the system for the user").

As taught by Kikuchi et al, various states of allowing erasure of copied data are well known and widely used, providing a user with the ability to restore useful storage media for storage of alternate data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kawara et al to incorporate a variety of possible erasure conditions for copied material.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (571) 272-7377. The examiner can normally be reached on 7:45-5:45 M-Th, first Fridays off.

Art Unit: 2621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JAF
8 December 2006


James J. Groody
Supervisory Patent Examiner
Art Unit 262 2621